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SEP 0 5 2006

OFFICE OF PETITIONS

In re Application of Miyazono et al. Application No. 09/903,068 Patent No: 6,982,319 Filed: July 11, 2001 Attorney Docket No. LUD5298.4 div

:DECISION GRANTING PETITION AND :NOTICE OF INTENT TO ISSUE :CERTIFICATE OF CORRECTION

This decision is in response to Patentees' "REQUEST FOR PATENT TERM ADJUSTMENT (37 CFR 1.702 ET SEQ. 1.705(D), 35 U.S.C. 154)" filed on January 9, 2006 requesting that the Office adjust the Patent Term Adjustment determined at the time of the issuance of the patent from a determination of zero (0) days to a determination of 753 (days).

Patentees' request is **GRANTED-in-Part.** The correct amount of PTA at the time of the issuance of the patent is 533 days. The Office will also adjust the PTA calculation to reflect this decision.

The Office will sua sponte issue a certificate of correction reflecting this decision. Patentee is given **ONE MONTH OR (30) DAYS** WHICHEVER IS LONGER to respond to this decision if patentee believe this decision is in error. No extensions of time under 37 CFR 1.136 will be granted.

Patentees submitted a request asserting that they were entitled to a determination of 753 days of PTA based upon USPTO failing to issue the application within three years of the filing date pursuant to 37 CFR 1.702(b), a 533-day delay and USPTO failing to issue the application within four months of the payment of the issue fee under 37 CFR 1.704(2), a 220 day delay. Patentees assert that the 432-day reduction against PTA is in error. Patentees do not mention the 120-day reduction but believe that applicant is contesting that as well since the applicant did not assert that any patentee delay occurred during the pendency of the application. Nor did applicant mention the additional 8 days under 37 CFR 1.702(a)(1).

Patentees arguments are persuasive to the extent herein indicated. The Office missed the requirements of 37 CFR 1.702(a)(1) by a period of 8- days as determined by the USPTO. The Office missed the requirements of 37 CFR 1.702(b) by a period of 533 days as asserted by applicant and determined by the USPTO. As for the requirement of 37 CFR 1.702(a)(4), the Office asserts that the applicants responded to the April 21, 2004 notice of allowance on April 29, 2004 mailing an PTOL-85(B) equivalent back to the USPTO in which the patentee advised

the Office that the issue fee had been previously paid.¹ Accordingly, the Office's four month requirement under the patent term provisions of 35 U.S.C. § 154(b)(1)(A)(iv) and 37 CFR 1.702(a)(4) began on April 29, 2004.² The Office needed to issue the patent on/before August 29, 2004 to avoid USPTO delay. Accordingly, the amount of time delay in issuing the patent amount to 472 days.

Patentees are reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004). Accordingly, the correct amount of administrative delay is 533 (533) days not 1013 (533 + 8 +472) days.

As for patentees, the patentees did not fail to engage in any reasonable efforts to conclude prosecution of the application. The 432- day reduction is in error because applicant replied to the 4/21/2004 notice of allowance on April 29, 2004. The Office entry of issue fee payment on September 26, 2005 is in error. In addition, the 120-day reduction for the 4/29/2004 miscellaneous incoming letter is also in error. The submission of the PTOL-85B equivalent on April 29, 2004 is not considered a failure to engage in reasonable efforts to conclude prosecution of the application under 37 CFR 1.704(c)(10). Accordingly, the proper amount of PTA at the time of the issuance of the patent is 553 days.

After the mailing of this decision, the Office will forward this patented file to the certificate of correction branch for an issuance of a certificate of correction. The certificate of correction branch will await the thirty day or one month period and then issue this certification of correction.

The Office has assessed the \$200.00 fee to deposit account 50-0624. No additional fees are required in determining this request for reconsideration of PTA.

Any questions concerning this decision should be directed to Kery Fries, Senior Legal Advisor, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy at 571-272-7757.

Kery Fries

Senior Legal Advisor

¹Although applicant did not expressly state that they wanted the previously paid issue fee to be reapplied, the Office is construing the letter of April 29, 2004 as requesting reapplication of the previously paid issue fee.

²It is unclear to the USPTO how patentees determined the issue fee payment date to be February 25, 2004.

Application No. 09/903,068

Office of Deputy Commissioner for Patent Examination Policy

cc: Draft certificate of correction Adjusted PAIR calculation



PALM INTRANET

Day: Saturday Date: 9/2/2006 Time: 11:39:21

PTA Calculations for Application: <u>09/903068</u>								
Application Filing Date: 07/11/2001	PTO Delay (PTO): 541							
Issue Date of Patent: 01/03/2006	Three Years: 0							
Pre-Issue Petitions: 0	Applicant Delay (APPL): 552							
Post-Issue Petitions: 0	Total PTA (days): 533							
PTO Delay Adjustment: 544								

File Contents History								
Number	Date	Contents Description	PTO	APPL	START			
82	09/02/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		8				
81	09/02/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	552					
75.5	12/14/2005	PTA 36 MONTHS	533					
75	01/03/2006	PATENT ISSUE DATE USED IN PTA CALCULATION						
74	11/28/2005	RECEIPT INTO PUBS						
73	11/28/2005	DISPATCH TO FDC						
72	11/28/2005	APPLICATION IS CONSIDERED READY FOR ISSUE						
70	11/28/2005	WORKFLOW - SIGNATORY REVIEW - FINISH						
69	09/26/2005	ISSUE FEE PAYMENT VERIFIED						
68	11/21/2005	RECEIPT INTO PUBS						
67	09/26/2005	ISSUE FEE PAYMENT VERIFIED		432	49			
66	11/02/2005	WITHDRAW PUBLICATION/PRE-EXAM ABANDON						
65	11/02/2005	PETITION TO REVIVE APPLICATION - GRANTED						
64	09/26/2005	PETITION ENTERED						
62	09/19/2005	MAIL ABANDONMENT FOR FAILURE TO PAY ISSUE FEE						
61	09/19/2005	ABANDONMENT FOR FAILURE TO PAY ISSUE FEE						
60	09/15/2005	RECEIPT INTO PUBS						
59	04/29/2004	MISCELLANEOUS INCOMING LETTER		120	55			
58	08/22/2005	RECEIPT INTO PUBS						
57	07/01/2005	WORKFLOW - QUERY REQUEST - FINISH						
56	03/22/2005	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE						

54 03/02/2005 MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT 53 10/18/2004 RECEIPT INTO PUBS 52 06/08/2004 SEQUENCE FORWARDED TO PUBS ON TAPE 51 06/17/2004 WORKFLOW - QUERY REQUEST - BEGIN 50 05/11/2004 WORKFLOW - FILE SENT TO CONTRACTOR 49 04/21/2004 MAIL NOTICE OF ALLOWANCE 48 04/21/2004 MAIL FORMAL DRAWINGS REQUIRED 47 04/21/2004 ISSUE REVISION COMPLETED 46 04/21/2004 FORMAL DRAWINGS REQUIRED	
52 06/08/2004 SEQUENCE FORWARDED TO PUBS ON TAPE 51 06/17/2004 WORKFLOW - QUERY REQUEST - BEGIN 50 05/11/2004 WORKFLOW - FILE SENT TO CONTRACTOR 49 04/21/2004 MAIL NOTICE OF ALLOWANCE 48 04/21/2004 MAIL FORMAL DRAWINGS REQUIRED 47 04/21/2004 ISSUE REVISION COMPLETED 46 04/21/2004 FORMAL DRAWINGS REQUIRED	
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47 04/21/2004 ISSUE REVISION COMPLETED 46 04/21/2004 FORMAL DRAWINGS REQUIRED	
46 04/21/2004 FORMAL DRAWINGS REQUIRED	
46 04/21/2004 FORMAL DRAWINGS REQUIRED	
45 04/21/2004 NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED	
44 04/21/2004 CASE DOCKETED TO EXAMINER IN GAU	
43 04/21/2004 NOTICE OF ALLOWABILITY	
42 04/20/2004 DATE FORWARDED TO EXAMINER	
41 04/06/2004 SUPPLEMENTAL RESPONSE	
40 04/16/2004 CRF IS FLAWED TECHNICALLY / NOT ENTERED INTO DATABASE	
39 04/06/2004 WORKFLOW INCOMING AMENDMENT IFW	
38 03/11/2004 IFW AMENDED CASE PROCESSING COMPLETE	
37 02/25/2004 NEW OR ADDITIONAL DRAWING FILED	
36 03/11/2004 DATE FORWARDED TO EXAMINER	
35 02/25/2004 RESPONSE AFTER EX PARTE QUAYLE ACTION	
34 03/05/2004 ERROR(S) IN CRF CORRECTED BY STIC	
33 02/04/2004 MAIL EX PARTE QUAYLE ACTION (PTOL - 326)	
32 02/03/2004 EX PARTE QUAYLE ACTION	
31 01/30/2004 DATE FORWARDED TO EXAMINER	
30 01/30/2004 WITHDRAWAL OF NOTICE OF ALLOWANCE	
29 07/30/2003 ISSUE FEE PAYMENT RECEIVED	
28 05/20/2003 WORKFLOW - SIGNATORY REVIEW - BEGIN	
27 05/16/2003 MAIL NOTICE OF ALLOWANCE	
26 05/16/2003 MAIL FORMAL DRAWINGS REQUIRED	
25 05/16/2003 MAIL EXAMINER'S AMENDMENT	
24 05/16/2003 FORMAL DRAWINGS REQUIRED	
23 05/16/2003 NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED	
22 05/16/2003 EXAMINER'S AMENDMENT COMMUNICATION	

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21		NOTICE OF ALLOWABILITY			
20	03/19/2003	DATE FORWARDED TO EXAMINER			
19	02/14/2003	RESPONSE AFTER NON-FINAL ACTION			
18	12/11/2002	MAIL NON-FINAL REJECTION			
17	12/11/2002	NON-FINAL REJECTION			
16	10/15/2002	DATE FORWARDED TO EXAMINER			
15	10/14/2002	RESPONSE TO ELECTION / RESTRICTION FILED			
14	09/19/2002	MAIL RESTRICTION REQUIREMENT	8		-1
13	09/19/2002	REQUIREMENT FOR RESTRICTION / ELECTION			
12	09/09/2002	CASE DOCKETED TO EXAMINER IN GAU			
11	09/04/2002	CASE DOCKETED TO EXAMINER IN GAU			
10	03/19/2002	PRELIMINARY AMENDMENT			
9	07/11/2001	PRELIMINARY AMENDMENT			
8	01/30/2002	CASE DOCKETED TO EXAMINER IN GAU			
7	01/23/2002	APPLICATION DISPATCHED FROM OIPE			
6	01/22/2002	APPLICATION IS NOW COMPLETE			
4	01/17/2002	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
3	HER // E & / HOLDE	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
2	07/25/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	07/11/2001	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

PATENT

6,982,319 B2

DATED

Jan. 3, 2006

INVENTOR(S):

Miyazono et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (0) days

Delete the phrase "by 0 days" and insert - by 533 days--